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REMARKS

Telephone Conference of March 14, 2006

Applicants are grateful for the courtesy of the telephone conference of March 14, 2006. In that telephone conference, Applicants' attorney noted that in the February 17, 2006 Office Action ("2/17/06 Office Action"), the Examiner appears to be taking the position that the Yeager declaration under 35 C.F.R. § 1.132 ("Yeager declaration") submitted by Applicants on September 9, 2005 is insufficient to remove the Mersfeld reference discussed below. Applicants' attorney explained that it was his understanding, based on MPEP 716.10, that the Yeager declaration should be sufficient to remove the Mersfeld reference. The Examiner asked Applicants to put their arguments in writing and assured Applicants that he would consider their response. Applicants appreciate the Examiner's willingness to Applicants' arguments. Applicants' arguments are presented below, in the discussion of the obviousness rejection.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1-8, 10-11, 13-26 and 29-32 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,878,782 to Mersfeld et al. ("Mersfeld"). 2/17/06 Office Action, page 2, second paragraph. Applicants respectfully traverse this rejection.

The Examiner stated,

The rejection is maintained for the reasons as stated in the last Office action and for the following reasons:

Applicants' arguments are based on a Rule 132 declaration to state that the declaration need not provide factual evidence and need only provide an unequivocal declaration that he conceived the subject matter relied on by the Examiner. This is not convinced since Applicant does not provide evidence to show how others, such as Mersfeld and Colborn, have contributed to the claimed subject matter.

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2/17/06 Office Action, third and fourth paragraphs. Applicants respectfully disagree, and they continue to believe that the Yeager declaration is sufficient to remove Mersfeld as a reference.

Mersfeld, issued April 12, 2005 from an application filed April 9, 2002, is available only under 35 U.S.C. § 102(e)(2) against the present application, which was filed October 3, 2003.

Applicants respectfully assert that the Yeager declaration is sufficient to remove Mersfeld as a reference. The relevant section of the MPEP states,

When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application. Disclaimer by the other patentee or other applicant of the published application should not be required but, if submitted, may be accepted by the examiner.

MPEP, 8th Ed. incorporating Revision No. 4, § 716.10 (emphasis added). Thus, an unequivocal declaration under 37 C.F.R. § 1.132 by the present inventor is sufficient to remove as § 102(e) prior art a patent issued from an application filed jointly by the present inventor and another. A declaration by the other inventors of the prior art patent is not required. If the Examiner is relying on any authority that contradicts MPEP § 716.10, Applicants respectfully request that he cite that authority on the record.

Here, declarant Yeager has made the required unequivocal declaration in paragraph number 7 of his declaration:

7. I conceived the portions of paragraphs [0081] and [0084] of U.S. Patent Application Publication No. 2002/0169256 of Mersfeld et al. relied on by the Examiner in the claim rejections of the 6/23/04 office action and the 8/29/05 advisory action.

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Yeager declaration, page 2. Thus, Applicants respectfully submit that the Yeager declaration is sufficient to remove Mersfeld as a reference under 35 U.S.C. § 102(c)(2). Accordingly, Mersfeld is sufficient to overcome the rejection over Mersfeld, and Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-8, 10-11, 13-26, and 29-32 under 35 U.S.C. § 103(a) over Mersfeld.

In short, Applicants respectfully assert that all pending claims are in condition for allowance.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-1131 maintained by Assignee.

Respectfully submitted,

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